

*Appln. Serial No. 10/510,959
Amdt. Dated April 29, 2008*

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REMARKS/ARGUMENTS

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The Examiner issued a restriction requirement in the letter dated October 29, 2007 on the above-noted patent application and requested the Applicant make an election among Groups 1 – 355.

REMARKS

Pursuant to paragraph 1 of the office action, the Examiner has requested an election of invention as between 355 Groups of invention. This restriction requirement is based on the Examiner's position that each peptide and each nucleic acid molecule is a separate invention. Applicant elects with traverse, Group 58 (SEQ. ID. NO 69), claims 8 - 10.

In this regard the claims have been amended with traverse: claims 1 -7, 11 have been cancelled. claims 8 and 34 have been amended. claims 9 and 10 have been retained without further amendment. Claims 12 -33 have been amended where applicable and withdrawn pending potential rejoinder. New claims 35 – 52 have been added, support for which can be found in the application as originally filed, such as at page 24, line 6 and throughout the application.

This election is made without prejudice of pursuing other claim groupings either by rejoinder in the present application or by way of a divisional or continuation or continuation-in-part application, nor without prejudice of pursuing any other subject matter disclosed in the current claims or the application as filed.

Applicant respectfully traverses the Examiner's rejection as follows.

1. Pursuant to 35 U.S.C. 121, a request for restriction is not mandatory.
2. Pursuant to 37 CFR 1.141, more than one species of an invention can be claimed in one application as long as there is one allowable generic claim encompassing the species.
3. MPEP 803 states:
 - (a) *Under the statute>, the claims of< an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to*

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support separate patents and they are either independent (MPEP § > 802.01, § 806.06, and § 808.01<) or distinct (MPEP § 806.05 - § >806.05(j)<). and

(b) If the search and examination of >all the claims in an< application can be made without serious burden, the examiner must examine >them< on the merits, even though >they include< claims to independent or distinct inventions. [Emphasis added].

It is respectfully submitted that it would not be a burden on the Examiner to examine the peptide claims as originally on file or that are currently pendingsubmitted. This is exemplified by the fact that the Examiner, with respect to Groups 44-67, has indicated that all the peptides are classified in a single class: class 530, subclass 324. As such, multiple classes are not required to be searched. Further, although claims 8 – 10 (as amended) have been retained to elected Group 58, a new “generic” claim, claim 35, has been added that encompasses the species, in amended claims 8 – 10 and the new claims. The structural similarity lies in the fact that the isolated peptides are derived from a distinct region of the C-terminus of a class of teneurin peptides, that were not before isolated or known to themselves have the activity described.

In this regard, Applicant has added claim 35 to refer to a TCAP peptide in relation to human Teneurin M1 (SEQ. ID. NO. 8) and analogs, homologs and variants thereof and functional fragments thereof. It is submitted that this is in compliance with the USPTO written description requirements (see Examples 13 and 14). The application certainly provides examples of analogs, many species homologs and variants. Without prejudice to a position that that individual distinct peptides could not be separately patentable, the application now comprises a linking claim referring to one amino acid sequence which forms a unity of structure among the peptides claimed (new claim 35). It is submitted that the claims as amended address the Examiner’s concerns regarding unity of invention and are ready for examination and are properly examined in one application. Reconsideration of the Examiner’s restriction requirement is respectfully requested.

This relationship between the new claims 35 – 42 and 43 – 50 is that the first set is based on human Ten M1 (SEQ. ID. NO. 8) and the second on homolog mouse Ten M 1 (SEQ. ID. NO. 4). The difference between the teneurin c-terminal associated peptides is one amino acid, at the 4th aa position Gly (SEQ. ID. NO. 37) and Ser (SEQ. ID. NO. 69).

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Further the structural relationship between SEQ. ID. NOs. 69 and 70 is the addition of one amino acid. SEQ. ID. NOs 71 and 72 are their respective amidated peptides. Similarly, SEQ. ID. NOs. 37 and 38 have one amino acid difference and SEQ. ID. NOs. 39 and 40 are the respective amidated peptides.

In response to the Examiner's statement in paragraph 2, as 37 C.F.R. 1.475 (b) states that a product, a process specially adapted for the manufacture of the said product and a use of the said product can be retained in one patent application, method claims 12 - 33 have been withdrawn for future consideration for rejoinder if the present elected claims are allowed. Where applicable they have also been amended to include the limitations of the claims currently elected and those pending before the patent office.

In response to the Examiner's statement in paragraph 3, this reply includes (i) an election of an invention to be examined) and (ii) identification of the claims encompassing the elected invention. In this regard, the Applicant has elected with traverse invention of Group No. 58 (SEQ. ID. NO. 69) pertaining to claims 8 -10. As noted above, claims have been added to the application after said election. They are readable on the elected invention, claim 8 as currently amended, as they could be considered an analogue, derivative, homologue or variant of SEQ. ID. NO. 69 and due to structural similarities would not, it is submitted, be burdensome on the Examiner to Examine.

With regard to the Examiner's note in paragraph 4 regarding inventorship, Applicant is not currently aware of any change in inventorship, subject to a final decision on the said restriction requirement and pending allowance of claims.

Applicant wishes to retain the right to rejoinder as per paragraph 5 of the Examiner's restriction requirement. As such, although product claims directed to peptides have been elected, the related method claims have been withdrawn to be considered for rejoinder once the elected claims have been allowed. As necessary, they have also been amended to depend on or require the limitations of the elected product claims.

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Please note that the Examiner's comments in paragraph 6 of the restriction requirements is rendered moot in light of the failure of the new rules to come into effect and are thus the comments therein are considered to be or should be withdrawn.

The Commissioner is hereby authorized to charge any fee which may be required to fully reply and enter this response, including any claim fees or extensions of time fees, or otherwise to keep the application in good standing, to our firm's Deposit Account No. 15-0633.

Should the Examiner like to discuss the matter, she is kindly requested to contact Anita Nador at 416-601-7530 at her convenience.

Respectfully submitted,
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